



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,741	11/27/2001	Brigitte C. Phan	111465.129	3682

20995 7590 06/29/2006

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

LU, FRANK WEI MIN

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,741

Applicant(s)

PHAN ET AL.

Examiner

Frank W Lu

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 61-73 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,8,12,64,65,67 and 73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,9-11,13-28,61-63,66 and 68-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/9/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11/05 and 5/06
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species (1) (claim 63), species (4) (claim 66), and species (6) (claim 72) in the reply filed on April 19, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Since claims 5, 6, 8, 12, 64, 65, 67 and 63 have been withdrawn due to species election, the claims 1-4, 7, 9-11, 13-28, 61-63, 66, and 68-72 will be examined. Rejection and/or objection not reiterated from the previous office action are hereby withdrawn in view of the response filed on November 18, 2005.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. New Matter

Claims 1-4, 7, 9-11, 13-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 1634

The limitation “exposing the dual bead complex to a capture field on a disc by rotating the disc so as to move the dual bead complex to the capture field,” is added to the newly amended independent claim 1. Although the specification describes that binding of dual bead complex can be further facilitated by rotating the disc so that the dual bead complex can slowly move or tumble down the flow channel (e.g., see page 23, third paragraph), the specification fails to define or provide any disclosure to support such claim limitation because the phrase “rotating any kind of disc (ie., disc with a flow channel and disc without a flow channel) so as to move the dual bead complex to the capture field” is much broader than rotating a disc with a flow channel so as to move the dual bead complex to the capture field” as taught by the specification. Note that at page 22, line 26 to page 23, line 30 of the specification, Figures 15A-D, and original claim 20 as suggested by applicant (see applicant’s remarks, page 8, second paragraph) does not support such claim limitation.

MPEP 2163.06 notes “If NEW MATTER IS ADDED TO THE CLAIMS, THE EXAMINER SHOULD REJECT THE CLAIMS UNDER 35 U.S.C. 112, FIRST PARAGRAPH - WRITTEN DESCRIPTION REQUIREMENT. *IN RE RASMUSSEN*, 650 F.2D 1212, 211 USPQ 323 (CCPA 1981).” MPEP 2163.02 teaches that “Whenever the issue arises, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed...If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application.” MPEP 2163.06 further notes “WHEN AN AMENDMENT IS FILED IN REPLY TO AN OBJECTION OR REJECTION BASED ON 35 U.S.C. 112, FIRST PARAGRAPH, A STUDY OF THE ENTIRE APPLICATION IS OFTEN NECESSARY TO DETERMINE WHETHER OR NOT “NEW MATTER” IS INVOLVED. *APPLICANT SHOULD THEREFORE SPECIFICALLY POINT OUT THE SUPPORT FOR ANY AMENDMENTS MADE TO THE DISCLOSURE*” (emphasis added).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1634

5. Claims 61-63, 66, and 68-72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 61 is rejected as vague and indefinite. Since the isolating step does not indicate that an isolate contains the dual bead complex, if an isolate does not contain the dual bead complex, it is unclear how to perform exposing and detecting steps. Please clarify.

7. Claim 69 is rejected as vague and indefinite because it is unclear that capture bead in line 8 represents a first group of capture beads or a second group of capture beads or both the first group of capture beads and the second group of capture beads. Furthermore, since the isolating step does not indicate that an isolate contains the dual bead complex, if an isolate does not contain the dual bead complex, it is unclear how to perform exposing and detecting steps. Please clarify.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

Art Unit: 1634

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 69 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nilsen *et al.*, (US Patent No. 5,484,904, published on January 16, 1996) in view of Van Ness *et al.*, (US Patent No. 5,106,730, published on April 21, 1992).

Regarding claims 69 and 70, Nilsen *et al.*, teach mixing a first group of capture beads (ie., one part of multiple identical beads A) and a second group of capture beads (ie., another part of multiple identical beads A), the first group of capture beads and the second group of capture beads being different (ie., each individual bead A is different), each capture bead (ie., one of beads A) having at least one transport probe affixed thereto, reporter beads (ie., beads B), each having at least one signal probe affixed thereto, and a biological sample (ie., the sequence to be detected), under binding conditions so as to permit formation of a dual bead complex if the target agent is present in the sample, the reporter bead and capture bead each being bound to the target agent (see Figure 5, column 4, lines 36-38 and column 18); isolating the dual bead complex from the mixture to obtain an isolate (see column 18); exposing the isolate to a capture field on a support, the capture field having a capture agent that binds to the dual bead complex (see Examples 1 and 2 in columns 18-20 and Figure 6); and detecting the presence of the dual bead complex to indicate that the target agent is present in the sample (ie., detecting the dual bead complex using labeled macrobeads, see columns 19 and 20) as recited in claim 69 wherein the reporter beads include a first group of reporter beads (ie., first part of multiple identical beads B) and a second group of reporter beads (ie., another part of multiple identical beads B), the first

Art Unit: 1634

group of reporter beads and the second group of reporter beads being different (ie., each individual bead B is different) as recited in claim 70.

Nilsen *et al.*, do not disclose that a capture field is on a disc as recited in claim 69.

Van Ness *et al.*, teach that a capture oligonucleotide (ie., a capture field) is on a disc (ie., nytran discs) (see column 19).

Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to have performed the method recited in claim 69 in view of the patents of Nilsen *et al.*, and Van Ness *et al.*. One having ordinary skill in the art would have been motivated to do so because the simple substitution of one kind of support (ie., the support taught by Nilsen *et al.*,) from another kind of support (ie., the disc taught by Van Ness *et al.*,) during the process of making a support having a capture field, in the absence of convincing evidence to the contrary, would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made since the support taught by Nilsen *et al.*, and the support taught by Van Ness *et al.*, are used for the same purpose (ie., capture a nucleic acid).

Furthermore, the motivation to make the substitution cited above arises from the expectation that the prior art elements will perform their expected functions to achieve their expected results when combined for their common known purpose. Support for making the obviousness rejection comes from the M.P.E.P. at 2144.06, 2144.07 and 2144.09.

Also note that there is no invention involved in combining old elements in such a manner that these elements perform in combination the same function as set forth in the prior art without giving unobvious or unexpected results. *In re Rose* 220 F.2d. 459, 105 USPQ 237 (CCPA 1955).

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1, 69, and 70 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No.10/087,549. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims in this instant application is either anticipated by, or would have been obvious over, the reference claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). Although claims 1, 69, and 70 in this instant application are not identical to claims 1-15 of copending Application No.10/087,549, claims 1-15 in copending Application No.10/087,549 are

directed to the same subject matter and fall entirely within the scope of claims 1, 69, and 70 in this instant application. In other words, claims 1, 69, and 70 in this instant application is anticipated by claims 1-15 of copending Application No.10/087,549.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

In page 11, last paragraph bridging to page 12, first paragraph of applicant's remarks, applicant argues that "[A]pplicants do not concede that the claims in either application are obvious over one another. Applicants note that no claims have issued in this case or in copending Application No. 10/087,549. The language of pending claims in one or both applications may change before the issuance of any claim. As such, whether a terminal disclaimer is necessary cannot be determined until the issuance of at least one set of claims".

These arguments have been fully considered but they are not persuasive toward the withdrawal of the rejection. First, applicant does not explain why the claims in either application are obvious over one another. Second, applicant does not file a terminal disclaimer.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

Art Unit: 1634

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. No claim is allowed.

14. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

June 21, 2006



FRANK LU
PRIMARY EXAMINER